

App. Serial No.: 10/766,290  
Atty. Docket No.: 0059-014P1

### REMARKS

These remarks are in response to the Office Action dated March 8, 2007, which has a shortened statutory period for response set to expire June 8, 2007. A three-month extension, to expire September 10, 2007 (September 8, 2007 being a Saturday), is requested in a petition filed herewith.

### Claims

Claims 1-24 are pending in the above-identified application. Claims 1-24 are rejected over prior art. Claims 23-24 are amended and Claims 25-28 are added. Claims 1-22 remain as filed. Reconsideration is requested.

### Rejections Under 35 U.S.C. § 102

Claim 24 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Boyden (US 5,737,436). The Examiner writes:

Regarding claim 24, in **figure 1**, Boyden teaches a communications earpiece improvement comprising: a connection tube (14) for connecting and acoustically coupling a transducer enclosure (10) to an ear bud (20); and

In **Figure 2**, an elongated projection (30) for insertion into the connecting tube (14);

Since Boyden teaches that the projection (30) is slid into tube (14), and neglects to teach a mechanism for limiting the rotational movement of projection (30) within tube (14), **figure 2** it is interpreted as teaching that the connecting tube (14) can be rotated about the elongated projection, via rotational force applied by the wearer; and

Further wherein **Figure 2** illustrates that the end of the connecting tube (18) can be moved along the length of the elongated projection (30), note that **figure 2** illustrates that the connecting tube (14, 18) is disposed at the mid-length portion of projection (30).

Applicants respectfully traverse.

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The standard for anticipation is set forth in M.P.E.P. § 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants appreciate the Examiner's clear statement of grounds for rejection. The Examiner's citations to particular elements of the cited reference are particularly helpful.

Applicants respectfully assert that the connections to tube 14 (e.g., the connection between tube 14 and fitting 30) in Boyden are not intended to be adjusted by rotation or sliding as suggested by the examiner. For example, Boyden indicates, at Col. 6, Lines 18-22, that the connections are made with an adhesive or by a pressing operation. Thus, tube 14 "can be rotated about the elongated projection" only in the sense that temple 122 (Boyden, Fig. 7) can be "detached" from eyeglasses 124 by breaking it off at the hinge.

Although Applicants object to the Examiner's characterization of the tube 14 connections in Boyden, Applicants appreciate the Examiner raising this possible interpretation so that the claims can be clarified during prosecution. Therefore, Claim 24 is amended to now recite (in part): "a retainer on at least one of the connecting tube and the elongated projection, the retainer facilitating positional adjustment between the connecting tube and the elongated projection but preventing disengagement of the connecting tube and the elongated projection." Boyden does not disclose "positional adjustment between the connecting tube and the elongated projection" or "a retainer" that facilitates such positional adjustment. Therefore, Boyden does not anticipate amended Claim 24.

Withdrawal of the rejection under 35 U.S.C. §102 is respectfully requested.

#### Rejections Under 35 U.S.C. § 103

Claims 1-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Taenzer (US 6,009,183) in view of Boyden.

Applicants respectfully traverse.

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M.P.E.P. § 2142 sets forth the procedural framework for the examination process of determining obviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness...

M.P.E.P. §2143 sets forth the requirements of a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Thus, if any element of the *prima facie* case of obviousness is not met, the obviousness rejection is improper and should be withdrawn.

Claims 1-17:

Claim 1 recites (in part): "a second adjustment means for allowing movement of the sound horn selectively toward and/or away from the transducer enclosure portion." The Examiner admits that Taenzer does not clearly teach a second adjustment means, but asserts that Boyden discloses an adjustment means (18, 30) for connecting a sound horn (20) to a connection member (18). The Examiner further asserts that it would have been obvious to one of ordinary skill in the art to substitute the sound horn connection structure of Boyden for that of Taenzer to provide a releasable connection to permit the exchange of eartips.

Applicant respectfully asserts that the third element of the *prima facie* case is not met. In particular, Boyden does not teach or suggest any "adjustment means for allowing movement of the sound horn selectively toward and/or away from the transducer enclosure portion." Rather, Boyden merely describes the "securing" of tube 14 to fitting 30 on ear bud 20.

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Indeed, it would appear from Boyden that the connections are not adjustable, but rather are intended to be permanent. For example, Boyden describes the connections as follows:

The tubular member 14 is secured to the foam insert 20 either directly, for example, with an adhesive, or by pressing the tube over or onto a fitting which has been secured into the foam piece.  
(Col. 6, Lines 18-22, emphasis added)

Thus, tube 14 is attached by either adhesive or a pressing operation. The connections can not, therefore, be fairly considered an "adjustment means."

Applicant's are aware that Fig. 2 shows connecting tube 14 disposed at a mid-length portion of fitting 30. However, it is not a necessary conclusion that the connection is adjustable. There are many other possible explanations for the depiction in Fig. 2. For example, Applicant's note that the description of Fig. 2 explains the assembly process of securing tube 14 to fitting 30, so Fig. 2 could be showing tube 14 and fitting 30 in an intermediate position during assembly. Another possible explanation for the position of tube 14 in Fig. 2 is to make sure that at least a portion of fitting 30 is visible in Fig. 2 in other than hidden lines. Yet another possible explanation is that tube 14 may only need to be pressed on to fitting 30 the distance shown in order to be fully seated. For at least the reasons, the position of tube 14 in Fig. 2 does not make the connection inherently adjustable.

In addition, the connections cited by the Examiner can not be considered "adjustment means," because the connections do not provide any meaningful adjustment. For example, rotating fitting 30 within tube 14 (Boyden) provides absolutely no adjustment, because ear bud 20 is symmetrical about the axis of rotation. Rotating fitting 30 within tube 14 results in no physical change.

Similarly, sliding tube 14 slightly off of fitting 30 does not provide any adjustment, because tube 14 does not support ear bud 20. Instead, ear bud 20 is supported by the user's ear. Thus, sliding tube 14 slightly off of fitting 30 would simply lengthen the connection. In fact, Applicants note that, sliding tube 14 partially off of fitting 30 would most likely release the pressed connection, causing ear bud 20 to detach from tube 14.

Applicants note that tube 14 of Boyden appears to be flexible. This is apparently the case, because no other mechanism for centering the ear bud 20 in the user's ear canal is described. Therefore, if tube 14 is not flexible, then a custom tube 14 would be required for each

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individual user based on the unique size and shape of the particular user's ear. The connections cited by the Examiner do not provide the needed means of adjustment. For example, rotating fitting 30 within tube 14 will not center ear bud 20 in the user's ear canal. Similarly, pushing/pulling tube 14 on/off of fitting 30 would only slightly move ear bud 20 into or out of the ear canal. Furthermore, this type of adjustment is clearly not required in Boyden, because Boyden indicates that the ear bud 20 can be fixed to tube 14 with an adhesive. (Col. 6, Line 20)

For all of the foregoing reasons, Applicants respectfully assert that the connections shown and described in Boyden cannot reasonably be interpreted as "adjustment means." No adjustment is described in the reference. The reference states that tube 14 is "secured" to ear bud insert 20. Tube 14 appears to be flexible, so no additional adjustment is necessary. Furthermore, even if the connections are manipulated as suggested by the Examiner, no useful adjustment is achieved.

Because both Taenzer and Boyden fail to disclose "adjustment means for allowing movement of the sound horn selectively toward and/or away from the transducer enclosure portion" as recited in Claim 1, the third element of the prima facie case of obviousness is not met. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

In addition, the first element of the prima facie case of obviousness is not met, because there is no suggestion or motivation to combine the references. The Examiner asserts that providing a releasable connection to permit the exchange of eartips would have been a motivation for one skilled in the art to combine the references. However, the exchange of ear tips is not the same thing as the adjustability of the ear tips. The desirability of exchanging ear tips is completely independent of the adjustability of the ear tips. In addition, the exchange of eartips is directly contrary to the teaching of Boyden, which indicates that the ear tips can be attached with an adhesive or by pressing.

For the foregoing reasons, Applicants respectfully assert that the first element of the prima facie case of obviousness is not met. Indeed, neither reference nor the Examiner's arguments provide a suggestion or motivation for providing an adjustment means between the tubular connection member and the sound horn. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. §103.

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Claims 2-17 depend, either directly or indirectly, from Claim 1 and are, therefore, distinguished from the cited prior art for at least the reasons provided above with respect to Claim 1.

Claims 18-21

Claim 18 recites (in part): "the sound horn has a second generally hollow projection" and "the connection member is rotatably affixed at the other end to the second generally hollow projection." Therefore, Claim 18 is distinguishable over the cited references for reasons similar to those presented above with respect to Claim 1. In particular, the cited references when combined do not disclose a sound horn "rotatably affixed" to a tubular connection member. As indicated above, neither reference even remotely suggest adjustability between a sound horn and a tubular connecting member. In addition, for at least the reasons set forth above, there is no suggestion or motivation to combine the cited references. Therefore, the first and third elements of the prima facie case of obviousness are not satisfied, and Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 18 under 35 U.S.C. §103.

Claims 19-21 depend from Claim 18 and are, therefore, distinguished from the cited references for at least the same reasons as Claim 18.

Claim 22:

Claim 22 recites (in part): "the sound horn has a second generally hollow projection" and "the connection member is rotatably affixed at the other end to the second generally hollow projection." Therefore, Claim 22 is distinguishable over the cited references for at least the same reasons as Claim 18.

Claim 23 and 25-28:

Claim 23 is amended herein to include limitations directed to the textured surface of the sound horn. Support for the amendment can be found in Applicant's original disclosure at least at Page 10, Line 29 through Page 11, Line 9, and in Fig. 7. The prior art of record does not disclose these limitations of Claim 23.

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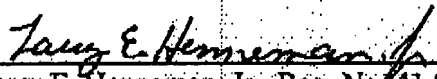
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For the above reasons Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

For the foregoing reasons, Applicants believe Claims 1-28 are in condition for allowance. Should the Examiner undertake any action other than allowance of Claims 1-28, or if the Examiner has any questions or suggestions for expediting the prosecution of this application, the Examiner is requested to contact Applicants' attorney at (269) 279-8820.

Respectfully submitted,

Date: September 10, 2007

  
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**CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted via facsimile, on the date shown below, to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at (571) 273-8300.

Date: September 10, 2007

  
Larry E. Henneman, Jr.